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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,540	05/31/2001	Miwako Doi	209249US2SRD	6767
22850	7590	10/04/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			REID, CHERYL M	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 10/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,540

Applicant(s)

DOI, MIWAKO

Examiner

Cheryl M. Reid

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/31/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 15 is objected to because of the following informalities: "Sever" is spelled incorrectly and should be replaced with "server". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The claims (1-16) are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Proper correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 7, 8 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart.

Claim 1

5. Stewart teaches of a call originating method applied to a mobile communication terminal for connecting the mobile communication terminal to a service provider over network using a connection information item corresponding to a service provider and a user's present location (Fig, 1A) , the method comprising: storing a plurality of connection information items corresponding to respective regional service providers, in a memory device (Col 10, lines 34-38) ; specifying the user's present location (Col 17, lines 11-13) retrieving, from the memory device, the connection information items corresponding to the specified user's present location (Col 11, lines 33-37) and a service that is required by the user (Col 13, lines 23-25); requiring the network to

connect the mobile communication terminal to the regional service provider, using a retrieved connection information item (Fig 4, Col 12, lines 55-56).

Claim 2

6. Stewart teaches of a call originating method applied to a mobile communication terminal for connecting the mobile communication terminal to another terminal over network using a connection information item corresponding to a destination the method comprising: storing a plurality of connection information items corresponding to a plurality of destinations, in a memory device (Col 10, lines 35-36, lines 39-40); specifying a user's present location (Col 4, lines 11-13); designating a destination (Fig. 1A), although didn't explicitly state, inherent because network (130) decides which service provider to connect MU to; retrieving a connection information item corresponding to a designated destination from the memory device (Fig 1A, item 130) (network 130 retrieves connection information relating to designated designation (service provider); converting the retrieved connection information item to another connection information item which permits the mobile communication terminal at a specified user's location to be connected to another terminal corresponding to the designated destination (Col 9, lines 48-52); requiring the network to connect the mobile communication terminal to another terminal corresponding to the designated destination, using a converted connection information item (Col 9, lines 52-55).

Claim 7

7. Stewart teaches of a mobile communication terminal comprising: a memory device configured to store a plurality of connection information items corresponding to a plurality of regional service providers(Col 10, lines 34-36); a location information acquiring device configured to acquire a location information item which permits s user's present location to be specified (Col 4, lines 11-13); a retrieval device configured to retrieve from the memory device, a connection information item corresponding to a specified user's present location (Col 4, lines 11-13) and a service that is required by the user (Col 11, lines 17-19); and a connection device configured to connect the mobile communication terminal to the regional service provider, using a retrieved connection information item (Fig 1, item 130).

Claim 8

8. Stewart teaches of a mobile communication terminal comprising: a memory device configured to store a plurality of connection information items corresponding to a plurality of destinations (Fig 1A, MIB); a location information acquiring device configured to acquire a location information item which permits a user's present location to be specified (Col 6, lines 15-17); a designation device configured to designate a destination(Col 18, lines 22- 24) (The network 130 designates which service provider (destination) to connect the mobile user to); a retrieval device configured to retrieve a connection information item corresponding to a designated destination, from the memory device(Fig 1A, items 130 and 150). The network (item 130) retrieves

connection information item corresponding to a designated destination, from the memory device(item 150) ; a connection information converter configured to convert the retrieved connection information item to another connection information item which permits the mobile communication terminal at the specified user's location to connect to another terminal corresponding to the designated destination (Col 9, lines 43-55); a connection device configured to connect the mobile communication terminal to the another terminal corresponding to the designated destination, using the converted connection information item (Col 9, lines 43-55).

Claim 15

9. Stewart teaches of a mobile communication terminal communicating with a plurality of regional server apparatuses and a plurality of regional service providers, comprising: a first memory device configured to store a plurality of first connection information items corresponding to the regional sever apparatuses (Fig 1A, item 150), the regional server apparatuses providing, to the mobile communication terminal, latest second connection information items corresponding to at least one of the regional service providers, the second connection information items permitting the mobile communication terminal to be connected to the regional service providers (Fig 1A); a location information acquiring device configured to acquire a location information item which permits a user's present location to be specified (Col 6, lines 15-17); a retrieval device configured to retrieve a first connection information item from the first memory device, based on a specified user's present location (Fig 1A, item 130); a connection

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device configured to connect the mobile communication terminal to one of the regional server apparatuses, using a retrieved first connection information item (Fig 1A, item 130), and to require for one of the regional server apparatuses to transmit the latest second connection information items corresponding to the specified user's present location (Fig 1A, item 130); a receiver configured to receive requested latest second connection information items from one of the regional server apparatus (Fig 1A, item 130); a second memory device configured to store received second connection information items (Col 8, lines 25-27). Examiner is interpreting "first connection information" and "second connection information" as any type of information that is related to connecting the mobile user to a service provider because this gives the broadest reason of interpretation.

10. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Agre.

Claim 14

11. Agre teaches of an information server apparatus communicating with a mobile communication terminal corresponding to a user's location, comprising; a memory device configured to store a plurality of latest connection information items corresponding to a plurality of regional service providers (Fig 1, item 10) ; a request reception device configured to receive a request for requesting latest connection information items corresponding to the user's location, from the mobile communication

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terminal (Fig 1, item 10). It is inherent that since the mobile telephone transmits ID of the service provider it was last registered with (Col 6, lines 42-43) that the gateway ground station (Fig 1, item 10) is capable of receiving the information; a retrieval device configured to retrieve requested connection information items, from the memory device (Fig 1, item 12); and a transmitter configured to transmit retrieved connection information items to the mobile communication terminal (Fig 1, item 14) .

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart as applied to claims 1, 7 and 15 above, and further in view of Voit.

Claim 3, 9 and 16

13. Stewart fails to teach about the connection information items indicating, a plurality of telephone numbers corresponding to connection points at which the mobile communication terminal is connected to Internet. Voit teaches of a system that uses dial-up methods to connect to the Internet. It is well known in the art that dial-up systems consist of a plurality of telephone numbers corresponding to connection points. Stewart's invention relates to providing a user with a mobile device access to networks (Col 2,

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lines 50-52). Modifying Stewarts invention to include a plurality of telephone numbers corresponding to connection points at which the mobile communication terminal is connected to the Internet would be an improvement because it would offer the mobile user additional methods of connecting to the network. It is for this reason that one skilled in the art would be motivated to make this modification to Stewart's invention.

14. Claims 4-6 and 10 -12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart as applied to claims 1,2, 7 and 12 above, and further in view of Agre.

Claims 4 ,5 , 10 and 11

15. Stewart fails to teach about the service that is required by the user is a service required in case of emergency and the service that is required by the user is a service required by dialing a telephone number in case of emergency. Agre teaches about the service that is required by the user is a service required in case of emergency and the service that is required by the user is a service required by dialing a telephone number in case of emergency (Col 3, lines 50-54). Stewart invention relates to providing a user with a mobile device access to networks (Col 2, lines 50-52). Modifying Stewart's invention to allow the user to access or contact a service required in case of emergency and the service that is required by the user is a service required by dialing a telephone number in case of emergency would be an improvement because it would

offer the mobile user additional feature and services. It is for this reason that one skilled in the art would have been motivated to make this modification to Stewart's invention.

Claims 6 and 12

16. Stewart fails to teach about wherein the connection information items indicate, domestic telephone numbers corresponding to a plurality of destinations, respectively, and the converted connection information item indicates an international telephone number. Agre teaches of a method wherein the connection information items indicate, domestic telephone numbers corresponding to a plurality of destinations, respectively, and the converted connection information item indicates an international telephone number (Fig 6). Stewart invention relates to providing a user with a mobile device access to networks despite users geographical location (Col 2, lines 50-52). Modifying Stewart's invention to include the above mentioned features would be an improvement because it would offer the mobile user additional features and services. It is for this reason that one skilled in the art would have been motivated to make this modification to Stewart's invention.

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franz and further in view of Agre.

Claim 13

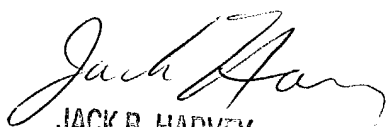
18. Franz teaches of a mobile communication terminal comprising, a first memory device configured to store dictionary data for translating user's native language into other languages and vice versa (Col 8, lines 38-42, lines 54-55); a second memory device configured to store a plurality of first location information items corresponding to one of the other languages, respectively (Fig 2, item 250). Examiner is interpreting "first location information" as any information that relates to languages because this gives the broadest reason of interpretation; a retrieval device configured to retrieve the dictionary data for translating the user's native language into the selected language and vice versa, from the first memory device (Fig 2); a translation device configured to translate the user's native language into the selected language and vice versa using retrieved dictionary data (Fig 2). Franz fails to teach about a location information-acquiring device configured to acquire a second location information item which permits a user's present location to be specified. Agre teaches about obtaining the present location of a user (Col 6, lines 55-59). Franz teaches about using a language selector configured to select a target language (Col 7, lines 65-67). It should be noted that although, Franz didn't explicitly state that his invention contains a language selector, it is inherent that it does because if it didn't his invention would not be able to accomplish the objective of allowing speakers of different languages to communicate (Col 7, lines 62-65). However, Franz is silent in regards to the language selection being based on the present location of the user. It is an objective of Franz's invention to allow speakers of different language to communicate with each other (Col 1, lines 20-24, lines 28-32). Modifying

Franz's invention to allow the user's present location to be a deciding factor in choosing which target language to provide the output in would be an improvement to Franz's invention because it would accomplish his objectives of relieving users of the need to possess specialized linguistic or translational knowledge (Col 1, lines 32-34). It is for this reason that one skill in the art would have been motivated to make this adjustment to Franz's invention.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M. Reid whose telephone number is 703 305-0435. The examiner can normally be reached on Mon- Fri (7-4:30) 2nd & 5th Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

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